

REMARKS

## Claim Rejections – 35 U.S.C. §112

In the Office Action dated June 3, 2004, Examiner rejected Claims 11, 23, 34, 46, 57, 69, and 74 through 79 under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement. Examiner asserts that the Specification as originally filed fails to provide support for the newly added limitation “said top surface is characterized by an absence of upstanding stems.” Applicant has amended the claims, replacing the phrase “said top surface is characterized by an absence of upstanding stems” with “said top surface is flat”.

Information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter. MPEP 2163.06.

Support for the amended claims is found in FIGS. 1-12 of the application as originally filed. Specifically, FIG. 1 clearly shows that the top surface 102 of skin layer 104 is flat. Therefore, Applicant respectfully submits that no new matter has been introduced by the amendments to the claims and that Claims 11, 23, 34, 46, 57, 69, and 74 through 79 are currently in condition for allowance. Withdrawal of the rejection is respectfully requested.

Examiner has provided no other basis for rejecting Claims 74 through 79 other than the §112 rejection discussed above. Since this rejection has been overcome by Applicant's amendments, Applicant respectfully submits that Claims 74 through 79 must be allowed.

Claim Rejections – 35 U.S.C. §102(e)

Claims 11, 34 and 57 were previously rejected in the Office Action dated January 23, 2004 under 35 U.S.C. §102(e), as being anticipated by Kobe et al. (US 6,610,382 B1). Applicant respectfully disagrees with Examiner's contentions.

Directing Examiner's attention to MPEP 2131, the threshold issue under Section 102 is whether the Examiner has established a *prima facie* case for anticipation. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)". "The identical invention must be shown in as complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1566 (Fed. Cir. 1989).

Claim 11

As amended, Claim 11 of the present invention recites a grip comprising "a skin layer having a top surface and a bottom surface, said top surface is flat; a 4-way stretchable material layer with a stretchable top surface and a stretchable bottom surface wherein said 4-way stretchable material comprises polyester, said top surface of said stretchable layer adhered permanently to said bottom surface of said skin layer; and a releasable adhesive disposed on said bottom surface of said 4-way stretchable layer."

Kobe does not teach a grip comprising a skin layer having a top surface that is *flat*. As seen in Fig. 1 and the description, Kobe teaches a skin layer having a top surface with upstanding stems, stating, "The article 20 includes a backing layer 21 having a first surface 24 with an array of upstanding stems 26." (Col. 3, lines 39-42).

Kobe further states that “As used herein, backing layer refers to an assembly having one or more layers supporting the upstanding stems ....” (Col. 4, lines 5-7).

As would be appreciated by one with ordinary skill in the art, there is a clear structural and functional distinction between the *flat* top surface in Claim 11 of the present invention and the top surface with *upstanding stems* in Kobe.

When a user grabs a skin layer with a flat top surface as in Claim 11 of the present invention, the user’s hand creates a seal with the surface, preventing any water from migrating underneath the hand, thereby ensuring a secure and non-slippery top surface underneath the user’s hand in wet conditions. On the other hand, when a user grabs a skin layer with upstanding stems as in Kobe, the stems prevent the user’s hand from creating a seal with the top surface. This absence of a seal allows water to originate from a portion on the top surface away from the user’s hand and travel in between the upstanding stems, and eventually underneath the user’s hand.

Also, a flat top surface can readily accept the application of ink, graphics, antimicrobial agents, antibacterial agents, adhesives, and other materials. In contrast, a top surface with upstanding stems cannot be treated with such materials since they would seep through the upstanding stems, away from the top surface and not adhere to the top surface.

These differences demonstrate why a surface with upstanding stems is not the same as a surface that is flat. Therefore, it is clear that the top surface in Kobe is not flat, and fails to teach this limitation of Claim 11 of the present invention.

Furthermore, Kobe does not teach a 4-way stretchable material with a top surface adhered permanently to the bottom surface of a skin layer and a releasable adhesive disposed on its bottom surface. In the Office Action dated January 23, 2004, Examiner asserts that the backing layer 22 acts as the 4-way stretchable material. In response to

this assertion, Applicant argued in an Amendment dated September 3, 2004 that Kobe states that backing layer 22 serves “to resist stretching”. (Col. 3, line 67; Col. 4, lines 1-2). Examiner responded in the Advisory Action dated October 6, 2004 that some of the materials listed in Kobe possess stretchability.

While Kobe may list examples of materials that possess stretchability, Examiner does not cite, nor can Applicant find, any reference to the *specific* backing layer 22 being stretchable. Backing layer 22 is the only layer in Kobe that corresponds to the same location as the stretchable layer in Claim 11 of the present invention, between the skin layer and the releasable adhesive. Since the only specific description of backing layer 22 refers to it serving “to resist stretching”(Col. 3, line 67; Col. 4, lines 1-2), Kobe does not adequately teach the 4-way stretchable layer as in Claim 11 of the present invention.

Applicant respectfully submits that Kobe fails to teach each and every element of Claim 11 of the present invention. Therefore, Claim 11 is currently in condition for allowance. Reconsideration and withdrawal of this rejection is respectfully requested.

#### Claim 34

The same arguments made for Claim 11 above are applicable to the patentability of Claim 34 as well. Applicant respectfully submits that Kobe fails to teach each and every element of Claim 34 of the present invention. Therefore, Claim 34 is currently in condition for allowance. Reconsideration and withdrawal of this rejection is respectfully requested.

Claim 57

The same arguments made for Claim 11 above are applicable to the patentability of Claim 57 as well. Applicant respectfully submits that Kobe fails to teach each and every element of Claim 57 of the present invention. Therefore, Claim 57 is currently in condition for allowance. Reconsideration and withdrawal of this rejection is respectfully requested.

Claim Rejections – 35 U.S.C. §103(a)

Claims 23, 46 and 69 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Kobe. Applicant respectfully disagrees with Examiner's contentions.

For a §103 obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1996).

Claims 23, 46 and 69 recite a grip comprising a skin layer having a top surface wherein "said top surface is flat ...."

As mentioned above, not only does Kobe fail to teach a skin layer having a flat top surface, but it actually teaches away from that limitation of the present invention by teaching a skin layer with a top surface having upstanding stems. Therefore, not only

does Kobe fail to disclose all of the elements of the present invention, but there is no motivation or suggestion to modify it so as to arrive at the present invention.

Applicant respectfully submits that Claims 23, 46 and 69 are currently in condition for allowance. Reconsideration and withdrawal of this rejection is respectfully requested.

If the Examiner has any questions regarding this application, the Examiner may telephone the undersigned at 775-586-9500.

Respectfully submitted,  
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